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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,478	05/29/2001	Kunihiro Tabuchi	P107390-00005	4389

7590

02/13/2003

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EXAMINER

HAWKINS, CHERYL N

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,478

Applicant(s)

TABUCHI, KUNIHIRO

Examiner

Cheryl N Hawkins

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1,2 and 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 3-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-2, drawn to a label pasting method, classified in class 156, subclass 264.
 - II. Claims 3-8, drawn to a label pasting device, classified in class 156, subclass 518.
 - III. Claim 9, drawn to a label material sheet, classified in class 283, subclass 74.
 - IV. Claims 10 and 11, drawn to a label with hot melt adhesive, classified in class 283, subclass 81.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process such as a process in which the cut labels are pasted onto a box.

Inventions III and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different

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process such as a process in which the label sheet material is die cut and inserted in plastic covers to create name badges.

Inventions I and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as a process in which the labels are cut out and then the adhesive is applied.

Inventions II and III are related as apparatus and product being worked upon. In the instant case, the inventions are distinct because the apparatus as claimed can be used for cutting and pasting another and material different product such as a layer of fabric.

Inventions II and IV are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case, the product as claimed can be made by another and materially different apparatus such as an apparatus that use a rotary knife roll to cut the labels and subsequently applies adhesive.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Attorney George Oram on February 7, 2003 a provisional election was made with traverse to prosecute the invention of Group II, claims 3-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1, 2, and 9-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

5. The abstract of the disclosure is objected to because the abstract should be limited to one paragraph. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites a label pasting device which comprises an anvil roller which is separated from the running surface of a packing sheet. However Claim 6 is dependent upon Claim 5, which recites a label pasting device which comprises an anvil roller which is disposed to be in contact with a running surface of a packing sheet. For the purposes of examination, it will be assumed that Claim 6 is dependent upon Claim 3.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US 4,992,125) in view of Parrish et al. (US 6,494,244). Suzuki et al. discloses a laminating device comprising an adhesive applicator (Figure 1, adhesive applicator 4) for applying a pressure-sensitive adhesive to a sheet material; a rotary cutter (Figure 1, cutter roller 10, suction roller 5) for cutting portions of the sheet material (Figure 1, elastic member 1) with pressure-sensitive adhesive; and a pasting device (Figure 1, suction roller 5) for pasting the cut portions of the sheet material on a indefinite-length web (Figure 1, backsheet 9). It is noted that the laminating device of Suzuki et al. is capable of applying adhesive, cutting, and pasting labels onto a packing sheet. Suzuki et al. does not disclose a die cutter. Parrish et al. discloses a laminating apparatus which utilizes a die cutter (Figure 2, rotary cutter 32; column 2, lines 39-42; column 7, lines 45-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to replace the rotary cutter of Suzuki et al. with a die cutter as suggested by Parrish et al. to provide the sheet material being cut with a variety of shapes.

As to Claim 4, Suzuki et al. discloses a laminating device in which the adhesive applicator (Figure 1, adhesive applicator 4) applies a hot-melt adhesive (column 2, lines 62-66). It is noted that the adhesive applicator, which can be nozzle, is capable of applying pressure-sensitive adhesive to an area within the outline of, and smaller than, each cut portion of the sheet

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material to be cut out by the cutter. Suzuki et al. discloses a laminating device which includes an adhesive applicator having its operation synchronized with the operation of a cutter (Figure 1).

When modifying the laminating apparatus of Suzuki et al. as noted above to include a die cutter, it would have obvious to synchronize the operation of the adhesive applicator with the operation of the die cutter to provide an apparatus which is automated to continuously and efficiently apply cut portions of a sheet material to an indefinite-length web.

As to Claim 5, Suzuki et al. discloses a laminating apparatus in which an anvil roller (Figure 1, suction roller 5) functions as the mechanism for pasting the cut portions of the sheet material (Figure 1, elastic member 1) and the anvil roller is disposed so as to be rotatable in contact with a running surface of an indefinite-length web (Figure 1, backsheet 9) and provided with a vacuum mechanism (column 3, lines 5-15) which sucks each cut portion of sheet material onto the periphery of the anvil roller until the cut portion of the sheet material is pasted onto the indefinite-length web.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US 4,992,125) and Parrish et al. (US 6,494,244) as applied to claim 3 above, and further in view of Nash (US 5,674,345). Suzuki et al. discloses a laminating apparatus which includes a pressing belt which is disposed on the downstream side of the anvil roll to press each cut portion of sheet material onto the indefinite-length web (column 3, line 65 through column 4, line 2). Suzuki et al. does not disclose a laminating apparatus which includes an anvil roller which is separated from the running surface of the indefinite-length web and a conveying belt. Nash discloses a labeling apparatus which includes an anvil roller (Figure 1, anvil cylinder 21) which is separated

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from the running surface of an envelope and a conveying belt (Figure 1, transport mechanism 30) which is disposed between the anvil roller and the top surface of the envelope and carries each label received from the anvil roller in the running direction of the envelope to insure that the labels stay in place until it is desired to remove them and place them onto envelopes (column 4, lines 12-49). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Suzuki et al. to include an anvil roller which is separated from the running surface of the indefinite-length web and a conveying belt as suggested by Nash to insure that the labels stay in place on the conveying belt until their removal and placement on the indefinite-length web is desired.

11. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US 4,992,125) and Parrish et al. (US 6,494,244) as applied to claim 3 above, and further in view of Ahr (US 5,837,087). Suzuki et al. does not disclose a laminating apparatus which includes a vacuum belt being laid around a small diameter roller and a large diameter roller nor a pair of pressure rollers. Ahr discloses a laminating apparatus which includes a vacuum belt unit disposed on the exit side of a cutter (Figure 1, cutter 36), the vacuum belt unit including a small-diameter roller disposed close to the exit of the cutter (Figure 1, vacuum conveyor belt 40); a large-diameter roller which is disposed so as to be in contact with the packing sheet and provided with a vacuum mechanism (Figure 1, rotatable roller 42); a vacuum belt which is laid around the small-diameter roller and the large-diameter roller and has many ventholes (Figure 1, connection 41; column 4, lines 45-56); and a pair of pressing rollers which are disposed on the downstream side of the large-diameter roller to press each cut portion of sheet material onto the running web

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(Figure 1, compression rollers 71). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Suzuki et al. to include a vacuum belt being laid around a small diameter roller and a large diameter roller as suggested by Ahr to insure that the labels stay in place on the conveying belt until their removal and placement on the indefinite-length web is desired.

12. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nash (US 5,674,345) in view of Suzuki et al. (US 4,992,125) and Parrish et al. (US 6,494,244). Nash discloses a labeling apparatus for applying pressure-sensitive adhesive labels (column 3, lines 18-30) which includes a rotatable cutter (Figure 1, cutting cylinder 26) for cutting labels (Figure 2, labels 24) from a label sheet material (Figure 1, label tap 11) with pressure-sensitive adhesive and a label applicator for applying the cut labels on the running surface of an envelope. It is noted that the laminating device of Nash is capable of cutting and pasting labels onto a packing sheet. Nash does not disclose an adhesive applicator. Suzuki et al. discloses a laminating apparatus which includes an adhesive applicator (Figure 1, adhesive applicator 4) for applying pressure-sensitive adhesive to a sheet material prior to cutting. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the labeling apparatus of Nash to include an adhesive applicator for applying pressure-sensitive adhesive as suggested by Suzuki et al. to create linerless labels by utilizing a plain paper sheet material and subsequently applying adhesive. Nash does not disclose a die cutter. Parrish et al. discloses a laminating apparatus which utilizes a die cutter (Figure 2, rotary cutter 32; column 2, lines 39-42; column 7, lines 45-46). It would have been obvious to one of ordinary skill in the art at the time of the

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invention to modify the apparatus of Nash to include a die cutter as suggested by Parrish et al. to provide cut labels in a variety of shapes.

As to Claim 6, Nash discloses a labeling apparatus which includes an anvil roller (Figure 1, anvil cylinder 21) which is separated from the running surface of an envelope and a conveying belt (Figure 1, transport mechanism 30) which is disposed between the anvil roller and the top surface of the envelope and carries each label received from the anvil roller in the running direction of the envelope to insure that the labels stay in place until it is desired to remove them and place them onto envelopes (column 4, lines 12-49). Nash discloses a labeling apparatus having pressing rollers which are disposed on the downstream side of the conveying belt and pressing each label onto an envelope, but Nash does not disclose a labeling apparatus having a pressing belt for pressing each label onto an envelope. Suzuki et al. discloses a laminating apparatus which includes a pressing belt which is disposed on the downstream side of the anvil roll to press and maintain close contact between each cut portion of sheet material and an indefinite-length web (column 3, line 65 through column 4, line 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to replace the pressing rollers disclosed by Nash with a pressing belt as disclosed by Suzuki et al. to provide for good label adherence by prolonging close contact between the cut labels and the envelopes to which they are being applied.

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Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl N. Hawkins whose telephone number is (703) 306-0941. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone numbers for the organization where the application or proceeding is assigned is (703) 872-9310 for regular communications or (703) 872-9311 for After-Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0661.

Cheryl N. Hawkins

Cheryl N. Hawkins 2/10/03

February 10, 2003



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